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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,408	11/14/2000	Scott B. McClellan	4463US	8458

7590 12/02/2003  
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EXAMINER

ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 12/02/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/712,408

Applicant(s)

MCCLELLAN ET AL.

Examiner

Kathryn Odland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8,9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 4,7,10 and 12-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8,9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4. 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 12-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.
2. Claims 4, 7, and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in a telephone conversation with Andrew Nilles on November 24, 2003, as further discussed in the interview summary. Claims 1-3, 5, 6, 8, 9, and 11 are under consideration.

***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: element 48. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: elements 55 and 56. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Frazier et al. in US Patent No. 6,231,561.

Regarding claim 1, Frazier et al. disclose a method of blocking a tubular anatomical structure via grasping tissue on the interior of the tubular anatomical structure to form a tissue bundle having tissue from around the circumference of the tubular anatomical structure and applying a ligating structure to the tissue bundle, as recited throughout the specification and seen in figure 11, for example.

7. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ehlers in US Patent No. 5,224,497.

Regarding claim 1, Ehlers discloses a method of blocking a tubular anatomical structure via grasping tissue (via suction) on the interior of the tubular anatomical structure to form a tissue bundle having tissue from around the circumference of the

tubular anatomical structure and applying a ligating structure (38) to the tissue bundle, as recited throughout the specification and seen in figure 6, for example.

Regarding claim 3, Ehlers discloses that as applied to claim 1, as well as, a ligating structure that is a ligating band (38), as recited in column 4, lines 34-35.

Regarding claim 5, Ehlers discloses a method of ligating a tubular anatomical structure (50 and 51) having a wall surrounding a central lumen via inserting a first end of an elongated tubular element (such as 10 and associated components) into the lumen of the tubular anatomical structure, at least one ligating structure (such as 38) being secured at the first end of the tubular element, as seen in figure 6; extending a grasper (such as the vacuum via 32) out of the first end of the tubular element and through the at least one ligating structure, as recited in columns 3-4; grasping tissue from the wall of the anatomical structure with the grasper; retracting the grasper into the first end of the tubular element, as recited in columns 3-4 and seen in figures 1-6; drawing the grasped tissue with the grasper into the first end of the tubular element and through the ligating structure to form a bundle within the first end of the tubular element, as seen in figures 4-6; and releasing the at least one ligating structure (38) from the first end of the tubular element to contract about the tissue bundle to form a ligation of the tubular anatomical structure; freeing the tissue bundle from the grasper; and withdrawing the tubular element from the tubular anatomical structure, as recited in columns 3-4 and seen in figures 1-6.

Regarding claim 6, Ehlers discloses that as applied to claim 5, as well as, withdrawing the tubular element completely from the tubular anatomical structure, as recited in columns 3-4 and seen in figures 1-6.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehlers in US Patent No. 5,224,497 in view of Booth et al. in US Patent No. 5,653,690.

Regarding 8, Ehlers discloses that as applied to claim 5. However, Ehlers does not explicitly recite a grasper that is an elongated catheter having an inflatable end portion and a plurality of hooking structures positioned about and capable of moving with the inflatable end portion and inflating the inflatable end portion until at least a portion of the plurality of hooking structures are forced into the wall of the tubular anatomical structure to grasp tissue of the wall and deflating the inflatable end portion until it is capable of fitting into the first end of the elongated tubular element in the grasping step. On the other hand, Booth et al. teach a grasper that is an elongated catheter having an inflatable end portion and a plurality of hooking structures positioned

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about and capable of moving with the inflatable end portion and inflating the inflatable end portion until at least a portion of the plurality of hooking structures are forced into the wall of the tubular anatomical structure to grasp tissue of the wall and deflating the inflatable end portion until it is capable of fitting into the first end of the elongated tubular element, as recited throughout the specification, with emphasis on column 8 as well as seen in figures 1-35. Therefore, it would be obvious to one with ordinary skill in the art to provide the system of Ehlers with an inflatable portion with a plurality of hooking structures rather than or in addition to suction, for the purpose of enhanced gripping and stability.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehlers in US Patent No. 5,224,497 in view of Booth et al. in US Patent No. 5,653,690 and further in view of Behl et al. in US Patent No. 5,709,224.

Regarding claim 9, Ehlers as modified by Booth et al. disclose that as applied to claim 8. However passing electrical current through at least a portion of the plurality of hooking structures to cauterize the grasping tissue in the freeing step has not been explicitly recited. On the other hand, Behl et al. teach passing electrical current through at least a portion of structures to cauterize. Therefore, it would be obvious to one with ordinary skill in the art to further modify the invention to include electrical current through at least a portion of the plurality of hooking structures to cauterize in the passing step, as taught by Behl et al. for the purpose of ensuring proper closure.

11. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehlers in US Patent No. 5,524,497.

Regarding claims 2 and 11, Ehlers discloses that as applied to claims 1 and 5. However, a tubular anatomical structure that is a fallopian tube has not been explicitly recited. On the other hand, it is well known to use tie the fallopian tubes and it is within the scope of the invention and obvious to one with ordinary skill in the art to employ the device of Ehlers in the fallopian tube.

#### ***Double Patenting***

12. Claims 1-3, 5, 6, 8, 9, and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/079,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely reworded representations for the same subject matter, perhaps slightly more broad in some aspects while slightly more narrow in others.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US Patent No. 6,558,400; US Patent No. 6,077,289; and US Patent No. 3,635,223.

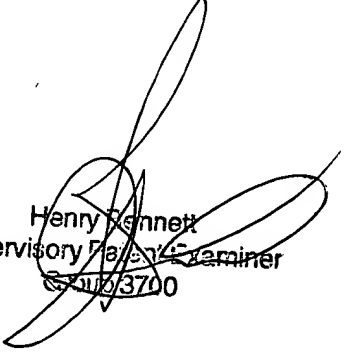


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KO

  
Henry Bennett  
Supervisory Patent Examiner  
(703) 308-0101